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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,224

Applicant(s)

BETROS ET AL.

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 21-39 and 43-45 is/are rejected.
- 7) ☒ Claim(s) 18-20, 40-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 10, 16-17, 21-28, 32, 38-39, 43, 44 and 45 are rejected under 35 U.S.C. 102(e) as being anticipated by Win et al. (U.S. Patent 6,453,353).

Claim 1: Reference is made to FIG. 1 of Win et al. A browser (100) issues a request for a document located at a data repository (protected server 104---also see abstract). The browser makes an http request (for example, col. 11, line 38), which is a request for HTML format documents from a server. An access server, operating in communication with a registry server (108) and registry repository (11) determines if the requester is authorized to access the given file. If the requester is authorized to view the document, the document is then translated from its stored format in the server (104) into an HTML page or web page displayed to the user (col. 11, lines 60-64).

Claim 2: Any information displayed to a user on an HTML page or web page is readable as graphical information.

Claim 3: The requested document is translated into an HTML page or web page upon the user's request for the document. An HTML page or web page is compatible with a browser.

Claim 4: As seen in FIG. 1, the repository (104) resides behind a firewall (above line 118 in FIG. 3). A metadata directory (110) resides in front of the firewall (below line 118). The structure (110) is considered to be a metadata directory since it contains information about the resources in the data repositories 104 (see col. 12, lines 32-40).

Claim 5: Col. 13, lines 2-3 refer to an administrative application which can delete or modify any of the records in the metadata directory (110). Deleting or modifying records in the metadata directory would be an updating of those records.

Claim 6: An access control element (108) cooperates in the system to control user access to the documents in repository (104).

Claim 10: An access control system (108) is provided outside of the firewall. The access control system contacts the directory (110) and determines which documents are available to which users. The request which is ultimately passed to the data repository (104) indicates which documents the particular user is allowed to view.

Claim 16: The request for documents located at repository (104) first passes to a staging database (106). The document format determination is made by browser (100), which determines the document format to be an HTML document or web page.

Claim 17: The document passes through staging database (106).

Claim 21: Document requester is provided with a menu (col. 11, line 53-64). This menu indicates which documents are accessible to the user, and reads as a status report on the document fulfillment request.

Claim 22: The document format is determined by the end user's browser. Merely providing an HTML document on that browser indicates a preference for an HTML format. The format preference for HTML is stored in the browser's code.

Claim 23: See remarks for claim 1.

Claim 24: See remarks for claim 2.

Claim 25: See remarks for claim 3.

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Claim 26: See remarks for claim 4.

Claim 27: See remarks for claim 5.

Claim 28: See remarks for claim 6.

Claim 32: See remarks for claim 10.

Claim 38: See remarks for claim 16.

Claim 39: See remarks for claim 17.

Claim 43: See remarks for claim 21.

Claim 44: See remarks for claim 22.

Claim 45: FIG. 1 of Win et al. discloses an interface element (100), access control logic (106, 108, 110), a translation engine (102) that converts a data stored on server (104) into an HTML or web page document at browser (100), and a storage element (104) that stores document data.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 8, 9, 11, 12, 13, 14, 15, 29, 30, 31, 33, 34, 35, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Win et al.

Claim 7: Claim 7 differs from Win et al. in that it recites the forwarding of a translated data file outside of the firewall to a response repository. However, it is well known in the art to forward documents to users, such as by e-mail. For example, the user at browser 100 could forward a received document to another user computer outside the firewall using a conventional

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e-mail system. The recipient's computer would thus be the response repository. It would have been obvious to one of ordinary skill in the art to modify Win et al. to permit e-mail transmission of documents to computer systems outside of the firewall, as is very well known in the art for permitting document sharing.

Claim 8: Any period of time that the document exists on the e-mail recipient's computer is a predetermined time in which the document resides at a response repository.

Claim 9: Any user at the e-mail recipient's computer is readable as an authorized requester, lacking any details as to exactly how authorization is achieved.

Claim 11: See remarks for claim 7.

Claim 12: See remarks for claim 8.

Claim 13: See remarks for claim 9.

Claim 14: The document translation is considered to be the conversion of the document from its stored format to an HTML page. In the same manner that the browser 100 may be configured to translate the document by displaying an HTML page, a browser at an e-mail recipient's computer may also be configured to display an HTML page.

Claim 15: Any display of a document as an HTML page is considered to be a translation of the document.

Claim 29: See remarks for claim 7.

Claim 30: See remarks for claim 8.

Claim 31: See remarks for claim 9.

Claim 33: See remarks for claim 7.

Claim 34: See remarks for claim 8.

Claim 35: See remarks for claim 9.

Claim 36: See remarks for claim 14.

Claim 37: See remarks for claim 15.

Claims 18-20 and 40-42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Remarks

Applicant's arguments have been considered.

Applicant argues that Win et al. does not make requests which specify a data format. However, the reference to Win et al. states that the requests from browser 100 are http requests, which is essentially a request for a document in a hypertext format, such as HTML. Examiner maintains that the claimed features in claim 1 are fully met by Win et al.

Applicant argues that Win et al. lacks format translation capabilities and a repository outside a firewall. However, Examiner maintains that when data is changed from its saved state in a protected server to its displayed state as an html page on a browser, its format is changed from the first state to the second state. In addition, examiner maintains that when a user e-mails a document to another user in a manner that is notoriously well known in the art, the computer that receives the document may be outside of a protective firewall and also functions as a repository since it saves the e-mail.

Applicant argues that the Examiner provides no justification or explanation for the rejection under 35 USC 103. However, an entire paragraph of explanation and justification was provided in the last office action and repeated verbatim in the present office action. For example,

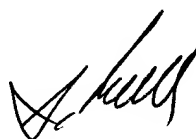
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see the remarks associated with claim 7, which provides the basic rationale for applying the obviousness rejection. In addition, specific reasons for obviousness (the advantage of document sharing) is explicitly recited in the action and not answered by applicant.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell  
Primary Examiner  
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